

REMARKS

In response to the non-final Office Action of March 13, 2007, applicants ask that all claims be allowed in view of the amendment to the claims and the following remarks. Claims 1, 3-27, and 29-56 are now pending in the application, with claims 1, 26, 27, and 52 being independent.

Double Patenting

Claims 1, 4-5, 7, 9-16, and 19 have been provisionally rejected as obvious over claims 1-2, 4, 7, 12-19, and 21 of co-pending Application Serial No. 10/334,129. Without conceding obviousness, applicants respectfully request that this provisional rejection be held in abeyance until the claims of both this application and those in Application Serial No. 10/334,129 are otherwise held to be allowable.

Claim Objections

The Office Action objected to claims 23-25 for improperly depending from claim 20. Applicants have amended claims 23-25 to depend from claim 22. Accordingly, applicants request reconsideration and withdrawal of the objection to claims 23-25.

Claim Rejections Under 35 U.S.C. § 101

Claims 27-52 have been rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. In particular, the Office Action contends that the recited computer readable medium may include a propagated signal and that a propagated signal does not qualify as statutory subject matter under 35 U.S.C. § 101. Without conceding the propriety of this contention but rather for the purpose of advancing prosecution, applicants have amended independent claims 27 and 52 to recite a tangible computer readable medium. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 27-52.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 3-6, 8, 10, 11, 19-21, 26, 27, 29-32, 34, 36, 37, 45-47, and 52 have been rejected under 35 U.S.C. § 102(b) as being anticipated by the Morpheus software program as described in www.archive.org's archived copy of the Morpheus download page on www.cnet.com (hereinafter "the Morpheus article"). Applicants request reconsideration and withdrawal of the rejection of claims 1, 3-6, 8, 10, 11, 19-21, 26, 27, 29-32, 34, 36, 37, 45-47, and 52 because the Morpheus article does not describe or suggest all of the subject matter of amended independent claims 1, 26, 27, and 52.

As amended, independent claim 1 recites a computer implemented method for sending a video clip in an instant messaging communications session. Among other features, the method includes storing, on a host system, a collection of video clips available to be sent to instant message recipients in instant messaging communications sessions, establishing an instant messaging communications session between an instant message sender and an instant message recipient, providing the instant message sender with access to the collection of video clips stored on the host system, receiving, at the host system, a request from the instant message sender for a particular video clip from among the collection of video clips stored on the host system to be delivered to the instant message recipient, and, in response to receiving the request for the particular video clip to be delivered to the instant message recipient, sending a video clip identifier corresponding to the particular video clip to the instant message recipient.

The Morpheus article describes a peer-to-peer (P2P) file-sharing application (i.e., Morpheus) that enables users of the MusicCity Network to make collections of digital media resident on their local computers available for search and download by other users of the MusicCity Network. That is to say, Morpheus enables users to search for and download digital media from the collections of digital media resident on the local computers of other users of the MusicCity Network. In addition, the Morpheus article also describes that Morpheus includes a built-in instant messaging client that enables users to engage in instant message conversations with other users. However, while the Morpheus article describes that Morpheus both enables users to download digital media resident on the local computers of other users and to engage in

instant message conversations with other users, the Morpheus article does not describe or suggest that Morpheus enables users to send and/or receive video clips in instant messaging communications sessions. Rather, the Morpheus articles describes a starkly different paradigm for sharing digital media that requires that a user proactively search the collections of digital media resident on the local computers of other users in order to locate and download desired digital media.

Therefore, it follows that the Morpheus article does not describe or suggest receiving, at a host system, a request from an instant message sender for a particular video clip from a collection of video clips stored on the host system to be delivered to the instant message recipient, and, in response to receiving the request for the particular video clip to be delivered to the instant message recipient, sending a video clip identifier corresponding to the particular video clip to the instant message recipient, as recited in independent claim 1. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claim 1 and its dependent claims 3-6, 8, 10, 11, and 19-21.

As amended, independent claim 27 recites features similar to those discussed above in connection with independent claim 1 and does so in the context of a computer program. Therefore, for at least the reasons discussed above in connection with independent claim 1, applicants request reconsideration and withdrawal of the rejection of independent claim 27 and its dependent claims, claims 29-32, 34, 36, 37, and 45-47.

As amended, independent claim 26 recites a computer implemented method for enabling perception of a video clip in an instant messaging communications session that includes, among other features, receiving an instant message that includes a video clip identifier corresponding to a selected video clip to be displayed by the instant messaging recipient system, the video clip having been selected by an instant message sender as a video clip to be sent to the instant message recipient in the instant messaging communications session.

As discussed above, the Morpheus article does not describe or suggest that Morpheus enables a user to send and/or receive a video clip in an instant messaging communications session. Therefore, it follows, that the Morpheus article does not describe or suggest receiving

an instant message that includes a video clip identifier corresponding to a selected video clip to be displayed by the instant messaging recipient system, the video clip having been selected by the instant message sender at an instant messaging sender system as a video clip to be sent to the instant message recipient in the instant messaging communications session involving the instant message recipient and the instant message sender, as recited in independent claim 26.

Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claim 26.

As amended, independent claim 52 recites features similar to those discussed above in connection with independent claim 26 and does so in the context of a computer program. Therefore, for at least the reasons discussed above in connection with independent claim 26, applicants request reconsideration and withdrawal of the rejection of independent claim 52.

Claim Rejections Under 35 U.S.C. § 103

Claims 7 and 33, which depend from independent claims 1 and 27 respectively, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Morpheus article in view of U.S. Patent No. 5,919,247 (hereinafter "Van Hoff"). However, Van Hoff does not cure the deficiencies in the Morpheus article noted above, nor does the Office Action contend that Van Hoff does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 7 and 33 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

Claims 9 and 35, which depend from independent claims 1 and 27 respectively, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Morpheus article in view of U.S. Patent Application Publication No. 2002/0049717 (hereinafter "Routtenberg"). However, Routtenberg does not cure the deficiencies in the Morpheus article noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Routtenberg does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 9 and 35 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

Claims 12-15 and 38-41, each of which depends from one of independent claims 1 and 27, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Morpheus article in view of U.S. Patent No. 6,070,171 (hereinafter "Snyder"). However, Snyder does not cure the deficiencies in the Morpheus article noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Snyder does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 12-15 and 38-41 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

Claims 16-18 and 42-44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Morpheus article in view of U.S. Patent No. 7,120,687 (hereinafter "Tessman"). However, 35 U.S.C. § 103(c) disqualifies Tessman from being used as the basis for an obviousness rejection under 35 U.S.C. § 103(a). Specifically, the present application is pending on or after December 10, 2004, Tessman only qualifies as prior art under 35 U.S.C. § 102(e), and the present application and Tessman were, at the time the invention was made, owned by, or subject to an obligation of assignment to, America Online, Inc. Consequently, 35 U.S.C. § 103(c) disqualifies the Watkins reference from being used as the basis of an obviousness rejection under 35 U.S.C. § 103(a). See MPEP § 706.02(1).

Claims 22-25 and 48-51, each of which depends from one of independent claims 1 and 27, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Morpheus article in view of Yubing Wang et al., Video: An Empirical Study of RealVideo Performance Across the Internet (hereinafter "Wang"). However, Wang does not cure the deficiencies in the Morpheus article noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Wang does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 22-25 and 48-51 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

New Claims

New claims 53-56 depend directly from one of independent claims 1 and 27. Accordingly, applicants submit that new claims 53-56 are allowable over the prior art of record for at least the reasons discussed above in connection with independent claims 1 and 27.

Conclusion

Applicants submit that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

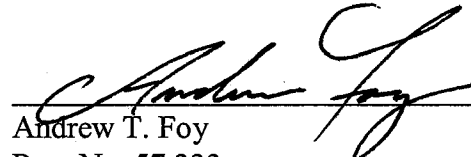
The fee in the amount of \$100 in payment of the Excess Claim Fee is being paid concurrently herewith by way of the Electronic Filing System (EFS). Please apply any other charges or credits to Deposit Account No. 06-1050.

Applicant : Noel Enete et al.
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Respectfully submitted,

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